

### **REMARKS/ARGUMENTS**

Reconsideration and allowance in view of the foregoing amendment and the following remarks are respectfully requested.

Claims 7-18 remain pending.

The applicant and the undersigned wish to thank Examiner Bastianelli for the courtesies extended during the interview of September 9, 2004. The amendment proposed during the interview is presented above and the arguments made are repeated herein for the record.

Original claims 7-17 were rejected under 35 USC 102(b) as being anticipated by DE 19934846 (Cornea). Applicant respectfully traverses this rejection.

Claim 7 has been amended above to incorporate a feature previously recited in claim 8, namely a valve member. Furthermore, claim 7 has been amended to provide that the valve member has an extending portion which directly contacts the slider without abutting any intervening structure. The abutting feature of the portion of the valve member was previously and is further recited in dependent claims 11 and 15-16 which even more specifically provide that the valve member includes a large diameter cylindrical portion and a small diameter cylindrical portion that abuts against the slider. Claim 15 provides that one end of the small diameter cylinder portion comprising the valve member includes a tubular portion made of non-magnetic material which abuts the slider. Support for these features may be found throughout the original disclosure and, in particular, at pages 32-33, more specifically page 33, lines 2-4, and in Figures 6-8.

Anticipation under Section 102 of the Patent Act requires that a prior art reference disclose every claim element of the claimed invention. See, e.g., Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1574 (Fed. Cir. 1986). While other references may be used to interpret an allegedly anticipating reference,

anticipation must be found in a single reference. See, e.g., Studiengesellschaft Kohle, G.m.b.H. v. Dart Indus., Inc., 726 F.2d 724, 726-27 (Fed. Cir. 1984). The absence of any element of the claim from the cited reference negates anticipation. See, e.g., Structural Rubber Prods. Co. v. Park Rubber Co., 749 F.2d 707, 715 (Fed. Cir. 1984). Anticipation is not shown even if the differences between the claims and the prior art reference are insubstantial and the missing elements could be supplied by the knowledge of one skilled in the art. See, e.g., Structural Rubber Prods., 749 F.2d at 716-17.

In Cornea, valve member 14 indirectly contacts the slider 45 through armature piston 50, which is formed separately from valve member 14 and slider 45. The separate formation and disposition of armature piston 50 is understood from the disclosure of Cornea, in particular from Figures 2-3, and Cornea's specification which explains that the Cornea invention relates to an armature piston and anti-stick disk formed as a monolithic part from a planar sheet metal and structurally independent from the valve member and slider. That the armature piston 50 is not only formed separately from the valve member but is also maintained as a separate component from the valve member is clearly understood as well from column 4, lines 50-57 of U.S. Patent No. 6,315,268 (which corresponds to the cited DE Cornea patent publication) which recites that it is necessary to ensure that valve member 14 will not beat on armature piston 50. Of course beating of the valve member 14 on the armature piston could only occur if the valve member were provided and maintained as a separate component from the armature piston. Thus, it is self-evident that the armature piston 50 is not only formed separately from valve member 14, but is not fixed thereto.

The invention as recited in applicant's claim 7 and the claims dependent therefrom provides the notable advantage over Cornea that because there is direct contact between the valve member and the slider, the number of assembly steps of the solenoid valve of the invention is reduced as compared to that of Cornea. Thus, not only is the invention different from Cornea, but the differences provide significant

advantages thereover. It is further respectfully submitted that it would be unobvious to modify Cornea so as to directly contact the slider structure with the valve member, because it is well established that it is improper to modify a primary reference in a manner that would destroy the invention thereof.

Indeed, it is not proper under 35 USC 103 to modify a prior art patent in a manner which would destroy that on which the invention of the prior art patent was based. Ex parte Hartman, 186 USPQ 366,67 (PTO Bd. App. 1974).

In this case, Cornea's invention is the formation of the armature piston, which is interposed between the slider and the valve member, as a monolithic component from a stamped, bent part rolled into a tubular member. It is therefore respectfully submitted that it would be unobvious under 35 USC 103 to combine Cornea with another secondary reference in an attempt to reject applicant's presented claims.

It is further respectfully noted that Cornea does not anticipate nor render obvious the structure even more specifically recited in claims 11 and 15 which more specifically characterize the valve member as including a large diameter cylindrical portion and a small diameter cylindrical portion, the small diameter cylindrical portion comprising the extending portion that abuts against the slider. Claim 16 which further provides that one end of the small diameter cylindrical portion includes a tubular portion made of non-magnetic material is also not taught or suggested by Cornea which teaches only the monolithic armature piston/anti-stick disk from planar sheet metal and does not teach the incorporation of a tubular non-magnetic part.

For all the reasons advanced above, reconsideration and withdrawal of the rejection based on Cornea et al is requested.

Applicants note with appreciation the Examiner's indication that claim 18 contains allowable subject matter. Claim 18 has been presented in independent form above and is therefore submitted to be allowable.

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All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance and an early Notice to that effect is earnestly solicited.

Respectfully submitted,

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By:

A handwritten signature in black ink, appearing to read "Michelle N. Lester", written over a horizontal line.

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